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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,984	03/23/2004	Donald E. Weder	8404.047	2284

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EXAMINER

GELLNER, JEFFREY L

ART UNIT PAPER NUMBER

3643

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,984

Applicant(s)

WEDER, DONALD E.

Examiner

Jeffrey L. Gellner

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 23 March 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Invention I (claims 1-31) in the reply filed on 30 November 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 32-57, drawn to the non-elected invention, were canceled in the reply filed 30 November 2004.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 20-23 of U.S. Patent No. 6,705,046 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a plant package with a potted plant and a tubular sleeve with a tapered, gusseted base with a detachable upper portion with detaching element, a

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decorative pattern/design with a non-linear upper boundary positioned below the detaching element and zone free of the decorative pattern/design between the detaching element and the non-linear boundary of the decorative pattern/design. The limitation in the dependent claims are similar.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-5, 7-9, 11-17, 20-22, 24, and 25 are rejected under 35 U.S.C. §102(b) as being anticipated by Newport (AU 42319/78; 1st document in Foreign documents section of Applicant's 1449).

As to Claims 1, 8, 12, Newport discloses a tubular sleeve (Figs. 1 and 2) comprising a base portion (region below 10 of Figs. 1 and 2) having a tapered shape and the lower end sized to contain a pot; an upper portion (region above 10 of Figs. 1 and 2) detachable from the base via a detaching element (10 of Figs. 1 and 2); a decorative pattern ("ABC" of Figs. 1 and 2) on the base with a non-linear upper boundary (for example, the letter "A" has a sides that are non-linear) below the detaching element (Figs. 1 and 2) and a pattern free zone between the detaching element and the non-linear upper boundary.

As to Claims 2 and 13, Newport further discloses the upper portion sized to substantially surround and enclose a floral grouping disposed in the pot (Fig. 2).

As to Claims 3, 4, 14, and 15, Newport further discloses the upper portion adapted to suspend (12 of Fig. 1) the tubular sleeve from support elements.

As to Claims 5, 9, and 16, Newport further discloses the peaks 15 mm (from Fig. 1 calculated to the top of the letter "A") below the detaching element and the trough 20 mm (from Fig. 1 calculated to the bottom of side of letter "A").

As to Claims 7, 11, and 17, Newport further discloses the sleeve in a flattened state (Fig. 1).

As to Claims 20 and 24, Newport discloses a potted plant (Fig. 2) and a tubular sleeve (Figs. 1 and 2) comprising a base portion (region below 10 of Figs. 1 and 2) having a tapered shape and the lower end sized to contain a pot; an upper portion (region above 10 of Figs. 1 and 2) detachable from the base via a detaching element (10 of Figs. 1 and 2); a decorative pattern ("ABC" of Figs. 1 and 2) on the base with a non-linear upper boundary (for example, the letter "A" has a sides that are non-linear) below the detaching element (Figs. 1 and 2) and a pattern free zone between the detaching element and the non-linear upper boundary.

As to Claims 21, ~~and~~ Newport further discloses the upper portion sized to substantially surround and enclose a floral grouping disposed in the pot (Fig. 2).

As to Claims 22 and 25, Newport further discloses the peaks 15 mm (from Fig. 1 calculated to the top of the letter "A") below the detaching element and the trough 20 mm (from Fig. 1 calculated to the bottom of side of letter "A").

Claim Rejections - 35 USC §103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 10, 18, 19, 23, and 26-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Newport (AU 42319/78; 1st document in Foreign documents section of Applicant's 1449) in view of Evans et al. (US 3,512,700; 6th document of page 3 of Applicant's 1449).

As to Claims 6, 10, 23, and 26, the limitations of Claims 1, 8, 20, and 24 are disclosed as described above. Not disclosed is the lower end with a gusset. Evans et al., however, discloses a sleeve with a bottom and a gusset in the bottom (Figs. 4 and 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the sleeve of Newport by adding a gusseted bottom as disclosed by Evans et al. so as to hold in any overflow water and to have a sleeve without puckers (see Evans et al. at col. 1 lines 53-63).

As to Claims 18, Newport discloses a tubular sleeve (Figs. 1 and 2) comprising a base portion (region below 10 of Figs. 1 and 2) sized to contain a pot; and, a decorative pattern ("ABC" of Figs. 1 and 2) on the base with a non-linear upper boundary (for example, the letter "A" has a sides that are non-linear) below the upper edge of the base portion (Figs. 1 and 2) and a pattern free zone between the upper edge of the base portion and the non-linear upper boundary. Not disclosed is the lower end with a gusset. Evans et al., however, discloses a sleeve with a bottom and a gusset in the bottom (Figs. 4 and 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the sleeve of Newport by adding a gusseted bottom as disclosed by Evans et al. so as to hold in any overflow water and to have a sleeve without puckers (see Evans et al. at col. 1 lines 53-63).

As to Claim 19, Newport as modified by Evans et al. further disclose the peaks 15 mm (from Fig. 1 calculated to the top of the letter "A" of Newport) below the detaching element and the trough 20 mm (from Fig. 1 calculated to the bottom of side of letter "A" of Newport).

As to Claims 27 and 30, Newport discloses a potted plant (Fig. 2) and a tubular sleeve (Figs. 1 and 2) disposed about the potted plant (Fig. 2) comprising a portion (region below 10 of Figs. 1 and 2) sized to contain a pot; an upper portion (region above 10 of Figs. 1 and 2) detachable from the base via a detaching element (10 of Figs. 1 and 2); and, a decorative pattern ("ABC" of Figs. 1 and 2) on the base with a non-linear upper boundary (for example, the letter "A" has a sides that are non-linear) below the detaching element (Figs. 1 and 2) and a pattern free zone between the detaching element and the non-linear upper boundary. Not disclosed is the lower end with a gusset. Evans et al., however, discloses a sleeve with a bottom and a gusset in the bottom (Figs. 4 and 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the sleeve of Newport by adding a gusseted bottom as disclosed by Evans et al. so as to hold in any overflow water and to have a sleeve without puckers (see Evans et al. at col. 1 lines 53-63).

As to Claim 28, Newport as modified by Evans et al. further disclose the upper portion sized to substantially surround and enclose a floral grouping disposed in the pot (Fig. 2).

As to Claims 29 and 31, Newport as modified by Evans et al. further disclose the peaks 15 mm (from Fig. 1 calculated to the top of the letter "A") below the detaching element and the trough 20 mm (from Fig. 1 calculated to the bottom of side of letter "A").

Conclusion

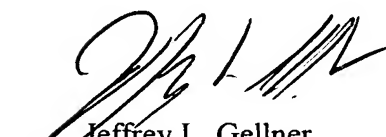
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weder ('378 A1) discloses the instant application's pre-grant publication.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey L. Gellner whose phone number is 703.305.0053. The Examiner can normally be reached Monday through Thursday from 8:30 am to 4:00 pm. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Peter Poon, can be reached at 703.308.2574. The official fax telephone number for the Technology Center where this application or proceeding is assigned is 703.872.9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.



Jeffrey L. Gellner
Primary Examiner